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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,313	04/24/2001	Kevin D. Weller	VISAP064/P-11702US	5667
75458	7590	05/20/2010		
Beyer Law Group LLP/Visa P.O. BOX 1687 Cupertino, CA 95015-1687			EXAMINER WORJLOH, JALATEE	
			ART UNIT	PAPER NUMBER
			3685	
			NOTIFICATION DATE	DELIVERY MODE
			05/20/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTOmail@beyerlaw.com

Office Action Summary	Application No. 09/842,313	Applicant(s) WELLER ET AL.	
	Examiner Jalatee Worjloh	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,8,10-21,32-40,42 and 45-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 7,8,10-19,33,42,45 and 46 is/are allowed.
- 6) ☒ Claim(s) 20,21,32,34-40,45-51,53,54,56 and 57 is/are rejected.
- 7) ☐ Claim(s) 52,55 and 58 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/12/2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. This Office Action is responsive to the amendment filed September 22, 2009.
2. Claims 7-8, 10-21, 32-40, 42, and 45-58 are pending.

Response to Arguments

3. Applicants' arguments filed March 8, 2010 have been fully considered but they are not persuasive.

Applicants' arguments with respect to claims 9-11 and 13 have been considered but are moot because these claims were either canceled or indicated as allowable.

4. Also, Applicants argue that Cook, Otto, and Krueger fail to teach verifying the enrollment of the customer account during the online transaction before the authentication request message is sent. However, this is not expressed the claims. At least claim 20 recites "performing a verification process ...to determine whether said customer account is registered", "to determine" is considered functional language, which is given less patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 3685

6. Claims 50, 53, and 54 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. The phrase "particular range" in claim 50 is a relative term which renders the claim indefinite. The phrase "particular range" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 20, 21, 32-36, 38, 40, 50, 51, 53, 54, 56, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Publication No. 2005/0131826 to Cook in view of U.S. Publication No. 2001/0029496 to Otto et al. ("Otto").

Referring to claims 20, 34, 38, and 40, Cook discloses receiving, by said issuer, authentication information concerning said customer, associating a designated password with said account (see paragraph [0027]), performing a verification process by said third party during said online transaction to determine whether said customer account is registered (see paragraph [0084] & [0007]), sending an authentication request message via a customer computer from a

Art Unit: 3685

third-party software module over a network during said online transaction, said request message being sent after said verification process; receiving said authentication request message at an access control server that is operated by said issuer, requesting over said network, by said issuer, of a password from said customer, verifying, by said issuer, that said password entered from said customer matches password previously designated for said account and sending over said network, by said issuer, an authentication response message to a third-party software module, said authentication response message containing an authentication status indicator, said response message being routed via said computer of said customer, whereby said issuer authenticates said customer for said third party, wherein said online transaction is a payment transaction, wherein said third-party software module sends authentication request message to a software module of said customer computer and wherein said customer computer then sends said authentication request message to said access control server (see claims 1, 4, 5, and 8). Cook does not expressly disclose verifying, by said issuer during a registration process, the identity of said customer as the owner of said account. Otto discloses verifying, by an issuer during a registration process, the identity of said customer as the owner of said account (see paragraphs [0037]-[0038]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method of Cook to include the steps of Otto. One of ordinary skill in the art would have been motivated to do this because it ensures that the user that is establishing the account is not fraudulent.

Claims 21 and 32 are rejected on the same rationale as claim 20 above.

Claim 35 is rejected on the same rationale as claim 34 above.

Art Unit: 3685

Referring to claim 36, Cook discloses wherein said financial transaction is a payment transaction (see abstract).

Referring to claims 50 and 51, Cook discloses querying a directory server by said third party to determine if said customer account is within a particular range and directly querying said access control server by said third party (see paragraphs [0062], [0072], and [0073]).

Claims 53, 54, 56 and 57 are rejected on the same rationale as claims 50 and 51 above.

10. Claims 37, 39, and 47-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cook and Otto as applied to claims 20 and 32 above, and further in view of U.S. Publication No. 2006/0143119 to Krueger et al. (“Krueger”).

Referring to claims 37, 39, and 47, Cook and Otto disclose the method of claim 20. However, Cook fails to teach said third-party software module sends said authentication request message to said access control server by way of a browser in said customer computer, and wherein said issuer sends said response message to said third party software module by way of said browser in said customer computer. Krueger discloses the missing elements of Cook (see abstract; paragraphs [0011], [0030] and paragraph [0031]). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method of Cook to include the steps of Krueger. One of ordinary skill in the art would have been motivated to do this because it ensures that the user that is establishing the account is not fraudulent.

Claims 47-49 are rejected on the same rationale as claim 37 above.

Allowable Subject Matter

11. Claims 7, 8, 10-19, 33, 42, 45, and 46 are allowed.

Art Unit: 3685

12. Claims 52, 55, and 58 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

13. The claim recites the functional language for. Applicant is reminded that functional recitation(s) using the word “for” or other functional language (“to determine) have been considered but given less patentable weight because they fail to add any steps and are thereby regarded as intended use language. A recitation of the intended use of the claimed invention must result in additional steps. See *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1375-76, 58 USPQ2d 1508, 1513 (Fed. Cir. 2001) (Where the language in a method claim states only a purpose and intended result, the expression does not result in a manipulative difference in the steps of the claim.).

“A whereby clause in a method claim is not given weight when it simply expresses the intended result of a process step positively recited.” *Minton v. Nat’l Ass’n of Securities Dealers, Inc.*, 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003).

14. “A whereby clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim.” *Tex. Instruments Inc. v. U.S. Int’l Trade Comm’n*, 988 F.2d 1165, 1172, 26 USPQ2d 1018, 1023 (Fed. Cir. 1993).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is 571-272-6714. The examiner can normally be reached on Monday - Friday 10:00 - 6:30.

Art Unit: 3685

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt II can be reached on 571-272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and 571-273-6714 for Non-Official /Draft.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jalatee Worjlloh/
Primary Examiner, Art Unit 3685